

### **Remarks/Arguments**

Applicants have received and carefully reviewed the Office Action of the Examiner mailed February 26, 2007. Currently, claims 37-58 remain pending. Claims 37-58 have been rejected. Favorable consideration of the following remarks is respectfully requested.

#### ***Claim Rejections – 35 USC § 103***

In paragraph 4 of the Office Action, claims 37-58 were rejected under 35 U.S.C. 102(e) as anticipated by Barbut et al. (U.S. Patent No. 5,997,557), or in the alternative, under 35 U.S.C. 103(a) as obvious over Barbut et al. (U.S. Patent No. 5,997,557) in view of Winston et al. (U.S. Patent No. 6,228,076). After careful review Applicant must respectfully traverse this rejection.

Turning to claim 37, which recites:

37. (Previously Presented) A percutaneous guidance catheter system, comprising:  
an elongate member having a proximal end, a distal end and a first lumen therebetween;  
an expandable filtration assembly having an expanded configuration that defines a distally facing cavity, the expandable filtration assembly being attached to the elongate member proximally of the distal end of the elongate member and extending distally beyond the distal end of the elongate member, the cavity including a gap between the distal end of the elongate member and the expandable filtration assembly, the gap extending longitudinally both distally and proximally from the distal end and extending radially from the distal end; and  
a therapeutic catheter at least partially disposed in the first lumen of the elongate member.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (MPEP § 2131). Therefore, in order to anticipate claim 37, Barbut et al. must teach each and every element in as complete detail as in claim 37. Applicant respectfully asserts that Barbut et al. fails to anticipate claim 37.

Nowhere does Barbut et al. appear to disclose, “the expandable filtration assembly being attached to the elongate member proximally of the distal end of the elongate member and extending distally beyond the distal end of the elongate member”, as recited in claim 37. Furthermore, on page 3 of the Office Action, the Examiner appears to acknowledge the shortcomings of Barbut et al. The Examiner states, “in figs 1 and 2, except for the expandable filtration assembling extending distally beyond the distal end of the elongate member or in figure 22, the filtration assembly including support struts being attached to the elongate member proximally of the distal end of the elongate member”. As such, Barbut et al. clearly does not teach a filtration assembly that is “attached to the elongate member proximally of the distal end of the elongate member and extending distally beyond the distal end of the elongate member”. Therefore, Barbut et al. fails to anticipate claim 37 under 35 U.S.C. 102(e) and Applicant respectfully requests withdrawal of the rejection.

Turning to the rejection under 35 U.S.C. 103(a), in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (See MPEP § 2143.03). As discussed previously, clearly Barbut et al. does not expressly teach all the claim limitations. However, the Office Action states that the filter assembling extending distally beyond the distal end of the elongate member “would have been obvious matter of design choice to modify the Barbut reference”. Applicant must respectfully disagree.

The claimed configuration uses the distal end of the elongate member to provide protection for the expandable filtration assembly. This configuration was designed for use with therapeutic catheters in general and ablation catheters in particular. Many therapeutic catheters are used to remove or destroy tissue or deposits and consequently have sharp edges, a high-energy tip or the like. These tips, suitable for the destruction of tissue, are likewise effective to damage or destroy an expandable filtration assembly. By attaching the expandable filtration assembly proximal of the distal end of the elongate member, a distal section of the elongate member in the expandable filter is created with a gap between the distal end and the expandable filtration assembly. This distal section serves at least two protective functions. First, it forms a barrier between the expandable filtration assembly and the distal end of the therapeutic catheter where the expandable

filtration assembly is closest to the elongate member, which eliminates the possibility of the potentially destructive therapeutic catheter distal tip from contacting and thereby damaging the proximal part of the expandable filtration assembly. Second, this distal section of the elongate member directs the therapeutic catheter towards the center of the space enveloped by the expandable filtration assembly in its expanded position and thereby makes it less likely that the therapeutic catheter distal tip will contact and damage the distal part of the expandable filtration assembly. As such, Applicant respectfully asserts that the claimed configuration is not an arbitrary design choice.

Furthermore, there must be some motivation provided in the art to make the design choice. The MPEP § 2144.04 recites:

### ***C. Rearrangement of Parts***

*In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). (Emphasis added).

Nowhere does Barbut et al. appear to disclose any motivation for modifying the catheter system to include, “the expandable filtration assembly being attached to the elongate member proximally of the distal end of the elongate member and extending distally beyond the distal end of the elongate member, the cavity including a gap between the distal end of the elongate member and the expandable filtration assembly, the gap extending longitudinally both distally and proximally from the distal end and extending radially from the distal end”, as recited in claim 37.

The Office Action states that the embodiment of Figure 1 and 2 of Barbut et al. can serve the protection functions described above. However, Applicant believes that there is no motivation to modify the embodiment of Figures 1 and 2 to have the

expandable filtration assembly extend distally of the distal end of the elongate member. Barbut et al. discloses providing holding strings (55) to connect the distal region (51) of the catheter to the expansion means (70). If the expansions means (70) extended distal of the distal end of the catheter, the holding strings would not be able to connect to the distal region (51), as shown in Figure 2. Therefore, for at least these reasons, Applicant believes that there is no motivation to modify the teachings of Barbut et al. Thus, claim 37 is believed to be patentable over Barbut et al. and Applicant respectfully requests withdrawal of the rejection.

Additionally, for similar reasons, as well as others, claims 38-58, which depend from claim 37 and include significant additional limitations, are believed to be not anticipated by Barbut et al. and patentable over Barbut et al. in view of Winston et al. and Applicant respectfully requests withdrawal of the rejection.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

Date:

May 21, 2007

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